



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,063	10/06/2000	Tsunetake Noma	202708US6	2851
22850 7590 01/07/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
			EXAMINER LEE, PHILIP C	
			ART UNIT 2152	PAPER NUMBER
			NOTIFICATION DATE 01/07/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

09/684,063

Examiner

Philip C. Lee

Applicant(s)

NOMA, TSUNETAKE

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

1. This action is responsive to the amendment and remarks filed on October 25, 2007.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/25/2007 has been entered.
3. Claims 1-17 are presented for examination.
4. The text of those sections of Title 35, U.S. code not included in this office action can be found in a prior office action.

Claim Rejections – 35 USC 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
6. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose "*receiving* data transmitted from the service providing apparatus *simultaneously* to all of the invention processing apparatuses belonging to the same group, the data including *a list of all of the information processing apparatuses currently accessing the shared server* and belonging to the same group to each of the information processing apparatuses in the same groups" as claimed in claim 1; "a transmission step of *simultaneously transmitting a list of all of the information processing apparatuses currently accessing the shared server...*" as claimed in claims 4, 5, 8 and 9; Claims 6, 12 and 15 also claim similar feature not disclose in the specification.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 12-14 and 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The following terms lack proper antecedent basis:

i. the invention processing apparatuses – claim 1.

b. Claim language in the following claims is not clearly understood:

ii. As per claim 1, lines 17-21, it is unclear how a service providing apparatus (line 1) comprising: fifth means for receiving data transmitted from the service

providing apparatus ... (i.e., comprising means for receiving data transmitted from itself).

iii. As per claims 12 (lines 4, 6, 13, 14 and 17), 14 (lines 2 and 3) and 15 (lines 4, 5, 7, 9, 15, 18, 23 and 25), the scope and metes and bounds are indefinite. Since the phrase "configured to" is not a requirement that it is performed, therefore it renders limitations after the phrase "configured to" to be moot.

Claim Rejections – 35 USC 101

8. Claims 1, 6, 12, and 15 are rejected under 35 U.S.C. 101 because "An apparatus" comprising: means or units (i.e., considered as software) does not include any functional structure of an apparatus (i.e., hardware structure of an apparatus). An apparatus comprising software is considered as program per se, which is not one of the categories of statutory subject matter.

Claim Rejections – 35 USC 103

9. Claims 1-5, 8 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agraharam et al, U.S. Patent 5,956,482 (hereinafter Agraharam) in view of Porter et al, U.S. Patent 6,675,299 (hereinafter Porter) and further in view of Kakuta et al, U.S. Patent Application Publication 2003/0093474 (hereinafter Kakuta).

10. Agraharam, Porter and Kakuta were cited in the last office action.

11. As per claim 1, 5 and 12, Agraharam taught the invention substantially as claimed for providing a service to a plurality of information processing apparatuses, the service providing apparatus functioning as a shared server on a network, comprising:

first means for storing a group (e.g. participation list predetermined code) (page 3, paragraphs 36 and 37), and content (page 1, paragraph 15);

second means for receiving a group request to include a corresponding one of the plurality of information processing apparatuses in one of the plurality of groups (e.g. participation list) (page 3, paragraphs 27 and 36), the group request selecting a respective one of the plurality of groups (page 3, paragraph 29), the group request transmitted from any of the information processing apparatuses belonging to one of the plurality of groups (page 3, paragraphs 27 and 36), and for receiving a content request (e.g. specifies the multimedia document) transmitting from any of the information processing apparatuses belonging to one of the plurality of groups, the content request including a selection of available content (page 3, paragraphs 28 and 34);

third means for acquiring data coordinated with the content request (page 1, paragraph 16);

fourth means for transmitting the data acquired by said third means simultaneously (page 1, paragraph 16) to all of those of the information processing apparatuses currently accessing the shared server and belonging to a same group (e.g. session audience) (page 2, paragraph 19; page 3, paragraphs 27 and 29); and

fifth means for receiving data transmitted from the service providing apparatus simultaneously to all of the invention processing apparatuses belonging to the same group (page 1, paragraph 2; page 2, paragraph 19).

12. Agraharam did not specifically teach storing a plurality of groups and a list of available content. Porter taught a shared file management system for storing a plurality of groups (col. 8, lines 21-31; col. 10, lines 33-48) and a list of available content (col. 11, lines 4-9, 26-32; col. 11, line 66-col. 12, line 6). Furthermore, Porter taught a selection from a list of available content (col. 9, line 62-col. 10, line 9).

13. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Agraharam and Porter because Porter's teaching of storing a plurality groups would increase the utilization of the shared server to provide services to multiple groups.

(Note that Agraharam's system must store a plurality of groups in order to provide services to multiple session audiences.)

14. Agraharam and Porter did not teach sixth means for transmitting a list of all of the information processing apparatuses currently accessing the server. Kakuta teaches means for receiving a list of all of the information processing apparatuses currently accessing the shared server and belonging to the same group to each of the information processing apparatuses in the same groups ([0069]) and means for transmitting a list of all of the information processing

apparatuses currently accessing the shared server and belonging to the same group to each of the information processing apparatuses in the same group ([0069], [0108], [0111]).

15. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Agraharam, Porter and Kakuta because Kakuta's teaching of transmitting a list of all of the information processing apparatuses currently accessing the shared server would increase the user alertness in Agraharam's and Porter's systems by providing a list of available users for communication.

16. As per claim 2, Agraharam, Porter and Kakuta taught the invention substantially as claimed in claim 1 above. Agraharam further taught wherein the data is music data (page 1, paragraph 15), and the selection is particular music data (page 2, paragraph 17; page 3, paragraphs 34 and 35).

17. As per claim 3, Agraharam, Porter and Kakuta taught the invention substantially as claimed in claim 1 above. Agraharam further taught comprising seventh means for receiving text data transmitted from any of the information processing apparatuses accessing the shared server and transmitting the text data to the least one other information processing apparatus accessing the shared server and belonging to the same group (page 3, paragraph 30).

18. As per claim 4, Agraharam taught the invention substantially as claimed for a service providing apparatus for providing a service to a plurality of information processing apparatuses accessing a single shared server on a network, comprising:

a storage controlling step of controlling a group (page 3, paragraphs 36 and 37), and content (page 1, paragraph 15);

a reception step of receiving a group request to include a corresponding one of the plurality of information processing apparatuses in one of the plurality of groups (e.g. participation list) (page 3, paragraphs 27 and 36), the group request selecting a respective one of the plurality of groups (page 3, paragraph 29), and for receiving a content request (e.g. specifies the multimedia document) transmitting from any of the information processing apparatuses belonging to one of the plurality of groups, the content request including a selection of available content (page 3, paragraphs 28 and 34), the group request and the content request received by the single shared server (BWS Center) (page 3, paragraphs 27 and 28);

an acquisition step of acquiring data coordinated with the content request (page 1, paragraph 16) to the single shared server (page 2, paragraph 19; page 3, paragraph 28);
and

a communication step of transmitting the data acquired by said acquisition step simultaneously from the single shared server (page 1, paragraph 16) to all of those of the information processing apparatuses currently accessing the single shared server and belonging to a same group (e.g. session audience) (page 2, paragraph 19; page 3, paragraphs 27 and 29).

19. Agraharam did not specifically teach storage controlling a plurality of groups and a list of available content. Porter taught a shared file management system for storage controlling a plurality of groups (col. 8, lines 21-31; col. 10, lines 33-48) and a list of available content (col. 11, lines 4-9, 26-32; col. 11, line 66-col. 12, line 6). Furthermore, Porter taught a selection from a list of available content (col. 9, line 62-col. 10, line 9).

20. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Agraharam and Porter because Porter's teaching of storage controlling a plurality groups would increase the utilization of the shared server to provide services to multiple groups.

(Note that Agraharam's system must store and control a plurality of groups in order to provide services to multiple session audiences.)

21. Although Agraharam taught a transmission step of simultaneously transmitting, however, Agraharam and Porter did not teach transmitting a list of all of the information processing apparatuses currently accessing the server. Kakuta teaches a transmission step of transmitting a list of all of the information processing apparatuses currently accessing the shared server and belonging to the same group to each of the information processing apparatuses in the same group ([0069], [0108], [0111]).

22. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Agraharam, Porter and Kakuta because Kakuta's teaching of transmitting a list of all of the information processing apparatuses currently accessing the shared server would increase the user alertness in Agraharam's and Porter's systems by providing a list of available users for communication.

23. As per claim 8, Agraharam taught the invention substantially as claimed for an information processing apparatus for accessing a service providing apparatus functioning as a single shared server, which provides services on a network, together with other information processing apparatuses, comprising:

an inputting step of inputting access information for accessing a single shared server of the service providing apparatus (BWS Center 100, fig. 1) to select a group (page 3, paragraph 37);

a display controlling step of controlling display of available contents transmitted from the single shared server of the service providing apparatus (page 2, paragraphs 20 and 21);

a requesting step of selecting content from the available content and requesting the single shared server of the service providing apparatus for transmission of the selected content to said information processing apparatus belonging to one of the plurality of groups and all the other information processing apparatuses currently accessing the shared server belonging to the same group (page 3, paragraphs 27, 29, 34 and 36);

reception step of receiving data transmitted from the single shared server of the service providing apparatus (e.g. BWS Center) to all of the information processing apparatuses belonging the same group (e.g. session audiences) (page 2, paragraphs 19 and 21); and reproduction step of reproducing the data (page 2, paragraph 19).

24. Agraharam did not specifically teach a plurality of groups and a list of available content. Porter taught a shared file management system for servicing a plurality of groups (col. 8, lines 21-31; col. 10, lines 33-48) and a list of available content (col. 11, lines 4-9, 26-32; col. 11, line 66-col. 12, line 6). Furthermore, Porter taught controlling display of a list of available content (col. 9, line 62-col. 10, line 9).

25. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Agraharam and Porter because Porter's teaching of a plurality groups would increase the utilization of the shared server to provide services to multiple groups.

(Note that Agraharam's system must store a plurality of groups in order to provide services to multiple session audiences.)

26. Although Agraharam taught a transmission step of simultaneously transmitting, however, Agraharam and Porter did not teach transmitting a list of all of the information processing apparatuses currently accessing the server. Kakuta teaches transmitting a list of all of the information processing apparatuses currently accessing the shared server and belonging to the

same group to each of the information processing apparatuses in the same group ([0069], [0108], [0111]); and a display step of displaying the list of all of the information processing apparatuses currently accessing the shared server and belonging to the same group ([0108], [0111]).

27. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Agraharam, Porter and Kakuta because Kakuta's teaching of a list of all of the information processing apparatuses currently accessing the shared server would increase the user alertness in Agraharam's and Porter's systems by providing a list of available users for communication.

28. As per claim 13, Agraharam, Porter and Kakuta taught the invention substantially as claimed in claim 12 above. Agraharam further taught wherein the data is music data (page 1, paragraph 15), and the selection is particular music data (page 2, paragraph 18).

29. As per claim 14, Agraharam, Porter and Kakuta taught the invention substantially as claimed in claim 12 above. Agraharam further taught a transmission unit configured to receive text data transmitted from any of the information processing apparatuses accessing the shared server and configured to transmit the text data to the at least one other information processing apparatus accessing the shared server and belonging to the same group (page 3, paragraph 30).

30. Claims 6,7, 9-11 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agraharam, Porter and Kakuta in view of Erdelyi, U.S. Patent Application Publication 2004/0056879 (hereinafter Erdelyi).

31. Erdelyi was cited in the previous office action.

32. As per claims 6, 9 and 15, Agraharam taught the invention substantially as claimed for accessing a service providing apparatus functioning as a shared server, which provides services on a network, together with other information processing apparatuses, comprising:

first means for inputting access information for accessing the service providing apparatus to a group (page 3, paragraph 37);

second control means for controlling display of available contents transmitted from the service providing apparatus (page 2, paragraphs 20 and 21);

third means for selecting content from among the available content and requesting the service providing apparatus for transmission of the selected content to said information processing apparatus belonging to one of the plurality of groups and the other

information processing apparatuses currently accessing the shared server belonging to the same group (page 3, paragraphs 27, 29, 34 and 36);

fourth means for receiving data transmitted from the service providing apparatus (e.g. BWS Center) simultaneously to all of the information processing apparatuses belonging the same group (e.g. session audiences) (page 2, paragraphs 19 and 21); and

sixth control means for reproducing the data (page 2, paragraph 19).

33. Agraharam did not specifically teach a plurality of groups and a list of available content. Porter taught a shared file management system for servicing a plurality of groups (col. 8, lines 21-31; col. 10, lines 33-48) and a list of available content (col. 11, lines 4-9, 26-32; col. 11, line 66-col. 12, line 6). Furthermore, Porter taught controlling display of a list of available content (col. 9, line 62-col. 10, line 9).

34. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Agraharam and Porter because Porter's teaching of a plurality groups would increase the utilization of the shared server to provide services to multiple groups.

(Note that Agraharam's system must store a plurality of groups in order to provide services to multiple session audiences.)

35. Agraharam and Porter did not teach transmitting a list of all of the information processing apparatuses currently accessing the server. Kakuta teaches transmitting a list of all of the information processing apparatuses currently accessing the shared server and belonging to the same group to each of the information processing apparatuses in the same group ([0069], [0108], [0111]); and fifth means for displaying the list of all of the information processing apparatuses currently accessing the shared server and belonging to the same group ([0108], [0111]).

36. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Agraharam, Porter and Kakuta because Kakuta's teaching of a list of all of the information processing apparatuses currently accessing the shared server would increase the user alertness in Agraharam's and Porter's systems by providing a list of available users for communication.

37. Agraharam, Porter and Kakuta did not teach specifically teach media player. Erdelyi taught inputting access information into a single window of a media player configured to access a service (page 3, paragraphs 54-57); controlling display of available content in the single window of the media player (fig. 4A; page 4, paragraph 59); selecting content from the available content in the single window of the media player (page 4, paragraph 59) and transmission of the selected content by activating a command in the single window of the media player (page 4, paragraphs 67; page 5, paragraph 80).

38. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teaching of Agraharam, Porter, Kakuta and Erdelyi because Erdelyi's teaching of a single window of a media player would enhance and make it easier for users in Agraharam's, Porter's and Kakuta's systems to input and to select information/contents utilizing the graphical interface.

39. As per claim 7, Agraharam, Porter, Kakuta and Erdelyi taught the invention substantially as claimed in claim 6 above. Porter further taught wherein the list of available content is a table

listing available music data (col. 7, lines 32-37) (i.e., the list of files may be audio data) provided from the service providing apparatus (col. 11, lines 4-9, 26-32; col. 11, line 66-col. 12, line 6), and the data is particular music data corresponding to the selected content (col. 9, line 62-col. 10, line 9; col. 11, lines 4-9; col. 11, line 66-col. 12, line 6).

40. As per claims 10, 11 and 17, Agraharam, Porter, Kakuta and Erdelyi taught the invention substantially as claimed in claims 6, 9 and 15 above. Erdelyi further taught activating a command by activating a play button in the single window of the media player (page 5, paragraphs 80 and 81).

41. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teaching of Agraharam, Porter, Kakuta and Erdelyi for the same reason as set forth in claims 6, 9 and 15 above.

42. As per claim 16, Agraharam, Porter, Kakuta and Erdelyi taught the invention substantially as claimed in claim 15 above. Porter further taught wherein the list of available content is a table listing available music data provided from the server providing apparatus, and the data is particular music data corresponding to the selected content (col. 11, lines 4-9; col. 11, line 66-col. 12, line 6; col. 7, lines 32-37).

43. Applicant's arguments filed 10/25/2007 have been fully considered but they are not persuasive.

44. In the remarks, applicant argument that:

- (1) Claims 1, 6, 12 and 15 clearly include functional structure, hence they are statutory.
- (2) The cited references fail to teach means for transmitting as claimed in claim 1.

45. In response to point (1), although applicant argued that the “means” correspond to “structure”, however, the disclosure is not automatically and inherently limited to hardware-inclusive embodiments. The broadest interpretation of the claimed "means" covers an embodiment of software alone. "An apparatus" as claimed without including hardware structure or without showing of “means” or “units” as hardware is merely software per se, which fails to fall within a statutory category of invention.

46. In response to point (2), Agraharam teaches broadcasting information to an audience of individual simultaneously ([0002]). Agraharam further teach clients can receive the broadcast session at the time specified by the session conductor ([0019]) (i.e., clients receive the presentation at the same time). This means the data is transmitted simultaneously as well as received simultaneously. Although Agraharam transmitted from the service providing apparatus simultaneously to all of the information processing apparatuses, however, Agraharam does not teach transmitting a list of all of the information processing apparatus currently accessing the server. Kakuta teaches means for transmitting a list of all of the information processing

apparatuses currently accessing the shared server and belonging to the same group to each of the information processing apparatuses in the same group ([0069], [0108], [0111]). Therefore, the combination of Agraharam and Kakuta teaches the means for transmitting as claimed.

47. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Lee whose telephone number is (571)272-3967. The examiner can normally be reached on 8 AM TO 5:30 PM Monday to Thursday and every other Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

P.L.

